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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,736	07/15/2003	Klaus Hilbig	CM2503RQ	7027

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,736

Applicant(s)

HILBIG ET AL.

Examiner

José A. Fortuna

Art Unit

1731

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/03; 8/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8 the word “plies” lacks of sufficient antecedent basis.

3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 8 recites the broad recitation joining plies, and the claim also recites, “preferably by embossing” which is the narrower statement of the range/limitation.

Art Unit: 1731

Claim 8 is vague and definite, because a broad range or limitation followed by linking terms (e.g., **preferably**, maybe, for instance, especially) and a narrow range or limitation within the broad range or limitation is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

4. In claim 9 the word "sheets" lacks of sufficient antecedent basis. Also the claim is vague and indefinite since it is unclear how this is done. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the intermediate steps before the web is ready to be cut, e.g., winding and forming rolls and then cutting to desired size, etc.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Wells, US Patent No. 3,414,459.

Regarding claims 1-3, 10-11, Wells teaches a tissue paper comprising multiple plies in which the plies are embossed with embossing rolls having from 16 to 400 protuberances/elements per square inch, (2.48 to 62 protuberances/elements per square centimeters), column 5, lines 62-65, and then calendered by passing it through a calender nip at lineal pressures between 0.5 to 60 pounds per lineal inch, (0.876 N/cm to 105.1

N/cm), column 5, lines 43-61. In column 5, lines 14-17, Wells teaches that a third ply can be interposed between the two embossed plies. Regarding claim 4, Wells teach that the height of the embossing elements is between 0.01 to 0.04 inch, (0.254 mm to 1.02 mm), which falls within the claimed range. Regarding claim 5, Wells in column 3, lines 64 through 66, teaches that the web is embossed by passing it through a nip between an steel roll, (the hard roll) and an rubber covered roll, (the rubber material roll). Regarding claims 6 and 8, Wells teaches that the web is formed by embossing at least two plies then laminating said at least two plies and then calendering the embossed-laminated plies, column 1, lines 51-55 and column 5, lines 6-16. With regard to claim 9, even though the step of cutting is not explicitly recited, the tissues need to be cut in order to the desired consumer product, i.e., paper towel, facial tissues, toilet tissues, etc., therefore, this limitation is inherent to the process of the cited reference, Wells.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1731

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wells, cited above. Wells does not teach the use of a lotion in the tissue. However, the use of lotions¹, emollients and other additives in tissues is conventional in the art and therefore, the use of lotion would have been obvious to one of ordinary skill in the art.
11. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al., WO 98/58124 in view of Roussel et al., WO 99/45205 or Kamps et al., US Patent No. 5,702,571.

Jennings et al. teach a tissue which is calendered and embossed, see abstract. They teach that the tissue is transported to a calendering unit that define a nip at a lineal pressure between 30 to 200 PLI, (52.5-350.25 N/cm), transported to an embossing unit comprising a pattern roll and a backing roll and then wound into a core and subsequently cut into appropriate widths, pages 8-10. In page 10, Jennings et al. teach that the embossing unit

¹ See for example US Patent No. 5,990,377 to Chen et al. or US Patent No. 6,352,700 to Luu et al., just to mention a couple.

Art Unit: 1731

comprises a backing roll comprising a smooth rubber covered surface and a hard roll, a steel roll. Jennings et al. is silent with regard to the number of embossing elements as claimed. However, Roussel et al. and Kamps et al., teach micro-embossing systems in which a tissue is embossed with an embossing device having at least 30 embossing elements /cm², see abstracts. They teach that the advantages of using such mechanism, device, are: produces a softer tissue, improved feel and good mechanical strength, see abstract of Roussel et al.; Kamps et al., abstract. Therefore, using a device as taught by Roussel et al or Kamps et al. would have been obvious to one of ordinary skill in the art in order to obtain the advantages discussed above. As to the use of a lotion¹, the use of lotions, emollients and other additives in tissues is conventional in the art and therefore, the use of lotion would have been obvious to one of ordinary skill in the art.

Conclusion

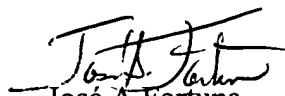
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Embossed- Calendered tissues."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



José A Fortuna
Primary Examiner
Art Unit 1731

JAF